

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/227,881 01/11/99 NGUYEN

T 07425.0057

022930 HM22/0829
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EXAMINER

SHIBUYA, M

ART UNIT

PAPER NUMBER

1635

DATE MAILED:

19
08/29/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

File copy

Office Action Summary

Application No.
09/227,881

Applicant(s)
NGUYEN ET AL.

Examiner
Mark L. Shibuya

Art Unit
1635



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 18, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 79-81 and 91-126 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 79-81 and 91-126 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 17
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 79-81, 91, 92, 96-98, 102-104, 108-110, 114-116, 120-122 and 126, drawn to a substantially purified nucleic acid comprising a nucleotide sequence that is either SEQ ID NO: 1, or a fragment of SEQ NO: 1 that comprises a functional regulatory region and is at least about 8 nucleotides in length, classifiable in class 536, subclass 23.1.
 - II. Claims 79-81, 91, 93, 96, 97, 99, 102, 103, 105, 108, 109, 111, 114, 115, 117, 120, 121, 123 and 126, drawn to a substantially purified nucleic acid comprising a nucleotide sequence that is either SEQ ID NO: 2, or a fragment of SEQ NO: 3 that comprises a functional regulatory region and is at least about 8 nucleotides in length, classifiable in class 536, subclass 23.1.
 - III. Claims 79-81, 91, 94, 96, 97, 100, 102, 103, 106, 108, 109, 112, 114, 115, 118, 120, 121, 124 and 126, drawn to a substantially purified nucleic acid comprising a nucleotide sequence that is either SEQ ID NO: 3, or a fragment of SEQ NO: 3 that comprises a functional regulatory region and is at least about 8 nucleotides in length, classifiable in class 536, subclass 23.1.
 - IV. Claims 79-81, 91, 95-97, 101-103, 107-109, 113-115, 119-121, 125 and 126, drawn to a substantially purified nucleic acid comprising a nucleotide sequence that

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is either SEQ ID NO: 34, or a fragment of SEQ NO: 34 that comprises a functional regulatory region and is at least about 8 nucleotides in length, classifiable in class 536, subclass 23.1.

2. The inventions are distinct, each from the other because of the following reasons:

3. Inventions of Groups I, II, III, and IV are unrelated, each from the other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different nucleotide sequences and fragments thereof, wherein said fragments are at least about 8 nucleotides in length, such that each different SEQ ID would require a separate nucleotide search.

4. The MPEP, in part, states:

Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions with the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 *et seq.*

MPEP 803.04. It has been determined that one sequence constitutes a reasonable number for examination purposes. Therefore, searching all of SEQ ID NOs: 1-3, 34, 37 and 38, and their respective fragments, would constitute a burdensome search on the nucleotide sequence searching resources of the Office.

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5. Because these inventions are distinct for the reasons given above and the sequence search required for each of Groups I, II, III, and IV are not required for the other Groups, restriction for examination purposes as indicated is proper.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

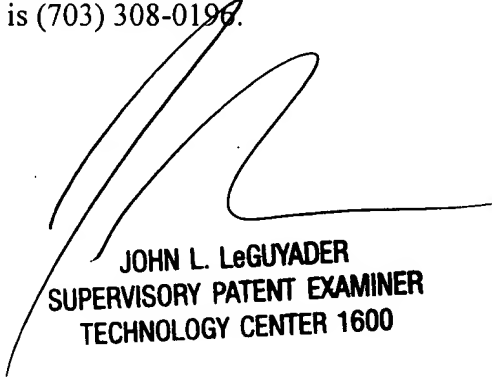
7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Mark L. Shibuya (SRC)*, whose telephone number is (703) 308-9355, and/or to the patent analyst, *Katrina Turner*, whose telephone number is (703) 305-3413.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *John LeGuyader* may be reached at (703) 308-0447.

10. Any inquiry of a general nature or relating to the status of this application should be directed to the *Group receptionist* whose telephone number is (703) 308-0196.

Mark L. Shibuya
Patent Examiner
Technology Center 1600
August 24, 2001



JOHN L. LeGUYADER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600